

PATENT
Old Docket No. 2950-0141P
New Docket No. 1630-0515PUS1

IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT: Je H. LEE et al.
APPLICATION NO.: 09/118,824
(Subsequently reissued as U.S. RE38,868 on
November 8, 2005)
(Reissue of U.S. Patent No. 5,587,789, which issued on
December 24, 1996)
FILED: July 20, 1998
FOR: APPARATUS AND METHOD FOR CONTROLLING
RECORDING AND REPRODUCTION IN DIGITAL
VIDEO CASSETTE TAPE RECORDER
ART UNIT: 2615
EXAMINER: Thai Tran

Mail Stop Petition
Commissioner For Patents
P.O. Box 1450

Alexandria, Virginia 22313-1450

March 17, 2008

**PETITION UNDER 37 C.F.R. §§ 1.67 AND 1.182 TO PLACE
SUPPLEMENTAL DECLARATIONS AND SWORN STATEMENTS IN FILE**

Sir:

Pursuant to 37 C.F.R. §§ 1.67 and 1.182, patentees and their assignee (hereafter, "Petitioners") hereby petition that the Supplemental Declarations of inventors Jehyoung Lee, Soo Kyung Kim, Sang Joon Woo and Tac Seok Yang, and the Sworn Statements of Gi-Up Cho, Dae Sul Shim and Yeo Han Yun be placed in the file of U.S. RE38,868 ("the '868 Reissue Patent"), which reissued on November 8, 2005 from U.S. reissue application 09/118,824 ("the '824 Reissue Application").

If, for some reason, the Petition under 37 C.F.R. § 1.182 is dismissed or not granted, please treat this as a Petition pursuant to 37 C.F.R. § 1.183, wherein Petitioners hereby petition that the Supplemental Declarations of the inventors and the Sworn Statements be placed in the file of U.S. RE38,868.

Petitioners seek to submit the above-referenced Supplemental Declarations of the inventors of the '868 Reissue Patent (*i.e.*, Mr. Jehyoung Lee, Mr. Soo Kyung Kim, Mr. Sang Joon Woo and Mr. Tae Seok Yang) because they have learned during litigation involving the '868 Reissue Patent that, in some instances, the inventors did not personally sign the declarations filed in relation to the '824 Reissue Application or U.S. application 08/227,281 ("the '281 Application"), which was the original patent application that issued as U.S. patent No. 5,587,789 upon which the '824 Reissue Application was filed. Instead, in these instances, the inventors authorized other employees of the assignee who were involved in the preparation and filing of materials related to the '824 Reissue Application or the '281 Application, Mr. Gi-Up Cho, Mr. Dae Sul Shim, or Mr. Yeo Han Yun, to have the appropriate declarations signed on the inventors' behalf. The Supplemental Declarations indicate that such procedures were undertaken by the inventors in good faith and without any intent to deceive the U.S. Patent and Trademark Office ("U.S.P.T.O.").

The Supplemental Declarations of the inventors of the '868 Reissue Patent also reaffirm that the statements made of their own knowledge in each of the declarations filed in relation to the '824 Reissue Application and the '281 Application

are true, and that all statements made on information and belief are believed by them to be true.

Petitioners also seek to submit the above-referenced Sworn Statements of Mr. Gi-Up Cho, Mr. Dae Sul Shim, and Mr. Yeo Han Yun, who were the employees of the assignee involved in the preparation and filing of materials related to either the '824 Reissue Application or the '281 Application, and who received authorization by the appropriate inventors to sign declarations on their behalves. The Sworn Statements of the above individuals indicate that each of them had mistakenly understood that the signature procedures they followed were acceptable, and they undertook such signature procedures in good faith without any intent to deceive the U.S.P.T.O.

The Supplemental Declarations and Sworn Statements set forth the facts and circumstances in which the declarations related to the '824 Reissue Application and the '281 Application were filed, and Petitioners, in an observance of good faith and candor, petition to have the Supplemental Declarations and Sworn Statements placed in the '868 Reissue Patent file wrapper.

Although there are no regulations or provisions specifically directed to the filing of Supplemental Declarations and Sworn Statements of the type attached hereto, Petitioners respectfully note that a similar petition was granted by the U.S.P.T.O. under the facts set forth in *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1344 (Fed. Cir. 2000), and that procedure was endorsed

by the U.S. Court of Appeals for the Federal Circuit in that case. In *Ajinomoto*, the patentee discovered during litigation that not all of the inventors personally signed declarations that were submitted during prosecution. *See id.* Instead, some of the inventors authorized others to sign on their behalf. *See id.* Upon this discovery, the patentee filed with the U.S.P.T.O. a supplemental declaration that contained the true signatures of the inventors, along with a petition to the Commissioner of Patents and Trademarks pursuant 37 C.F.R. §§ 1.67 and 1.182 requesting that the U.S.P.T.O. place the supplemental declaration in the patent's file wrapper. *See Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 1998 U.S. Dist. LEXIS 3833 at 24 (D. Del. 1998). In affirming the district court's finding that the patent-in-suit was valid, the Federal Circuit took into consideration the patentee's supplemental declaration, which stated that the procedure followed for the prior declarations, wherein some of the inventors authorized others to sign on their behalf, "was the result of a lack of knowledge of the technical requirements of U.S. patent law and was made without deceptive intent." *See Ajinomoto*, 228 F.3d at 1344. Petitioners seek to utilize procedures similar to those used in *Ajinomoto*, which were accepted by the U.S.P.T.O. and endorsed by the Federal Circuit.

This Petition is accompanied by:

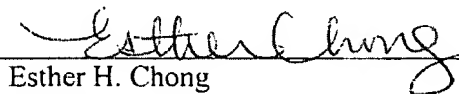
- (1) The Supplemental Declaration of Jehyoung Lee, dated January 6, 2008;
- (2) The Supplemental Declaration of Soo Kyung Kim, dated March 5, 2008;
- (3) The Supplemental Declaration of Sang Joon Woo, dated March 6, 2008;

- (4) The Supplemental Declaration of Tae Seok Yang, dated March 6, 2008;
- (5) The Sworn Statement of Gi-Up Cho, dated March 6, 2008;
- (6) The Sworn Statement of Dae Sul Shim, dated March 7, 2008;
- (7) The Sworn Statement of Yeo Han Yun, dated March 7, 2008;
- (8) Authorization to charge \$400.00 to Deposit Account No. 022448 in payment of the petition fee set forth in 37 C.F.R. § 1.17(f). The Director is also authorized to charge any other fees that may be required, or credit any overpayment to Deposit Account No. 022448.

Accordingly, Petitioners respectfully request that this Petition be granted and the above-identified Supplemental Declarations and Sworn Statements be placed in the file of the '868 Reissue Patent. Early and favorable consideration of this Petition is respectfully requested. Please contact the undersigned at the telephone number below for any outstanding matters.

March 17, 2008

Respectfully submitted,



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